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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Mark W. Brockman et al.	§	Art Unit:	3673
		§		
Serial No.:	10/701,325	§		
		§	Examiner:	John J. Kreck
Filed:	November 4, 2003	§		
		§		
For:	Inductively Coupled Method	§	Atty. Dkt. No.:	SHL.0152D1US
	and Apparatus of	§		(68.0114CIP/DIV)
	Communicating with Wellbore	§		
	Equipment	§		

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

The arguments presented below are in response to the Examiner's Answer dated December 13, 2005.

A. Reply to Examiner's Answer Regarding Claim 1

In response to Appellant's arguments that no motivation or suggestion existed to combine the teachings of Tubel and More, the Examiner points to a passage in More that describes a benefit of using inductive coupling (the passage in More starting at column 1, line 23). However, the Examiner did not go on to further explain why the statement of a benefit of inductive coupling provided in More (used in a single main wellbore environment) suggests the subject matter of claim 1, namely an inductive coupler mechanism to electrically communicate electrical signaling in the main bore with an electrical device in the lateral branch. However, the

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Examiner did note that “it is entirely possible that the inductive coupler disclosed in Tubel communicates electrical signaling in the main bore with equipment in the lateral branch as claimed in claim 1” As has been held in numerous cases, the mere fact that the prior art *could be* modified to form the claimed structure “would not have made the modification obvious unless the prior art *suggested the desirability of the modification.*” See, e.g., *In re Leskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989) (emphasis added); *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) (“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.”).

Neither Tubel nor More (nor any other objective evidence cited by the Examiner) provides any suggestion of the *desirability* to use an inductive coupler mechanism to electrically communicate between a main bore and a lateral branch.

In sum, the Examiner’s obviousness rejection is improperly premised on two points: (1) More’s teaching that inductive coupling may be beneficially used in a single main wellbore; and (2) that “it is entirely *possible* that the inductive coupler disclosed in Tubel communicates electrical signaling in the main bore with equipment in the lateral branch.” It is respectfully submitted that neither of the above points provides the requisite suggestion to modify the teachings of Tubel based on the teachings of More.

The only suggestion of the claimed subject matter is provided by the disclosure of the present invention. However, as noted previously, use of impermissible hindsight that benefits from the disclosure of the present invention to piece together teachings of prior art references is strictly prohibited. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (cited by the Examiner in the final rejection).

As the Examiner has failed to establish that any motivation or suggestion existed to combine the teachings of Tubel and More, it is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 1.

B. Reply to Examiner's Answer Regarding Claim 2

In response to Appellant's arguments presented in the Appeal Brief, the Examiner "agreed that since Tubel fails to teach the inductive coupler as claimed, and More fails to teach the lateral connector; the references together *do fail* to explicitly disclose an inductive coupler portion attached to the connector mechanism" Examiner's Answer at 10 (emphasis added). However, the Examiner stated that "one of ordinary skill in the art would have known to 'attach' the coupler portion to the well connector ... in order to prevent it from falling to the bottom of the well, or being swept away from fluid flow." *Id.*

No objective evidence has been provided by the Examiner regarding why a person of ordinary skill in the art "would have known" to attach an inductive coupler portion to the connector mechanism. There is no objective evidence to even remotely suggest that an inductive coupler portion can be attached to a connector mechanism, as recited in claim 2. The only basis for the rejection appears again to be the disclosure of the present invention, which constitutes impermissible hindsight. A *prima facie* case of obviousness has therefore not been established with respect to claim 2.

C. Conclusion

In view of the foregoing and in view of the arguments presented in the Appeal Brief, reversal of the final rejection is respectfully requested.

Respectfully submitted,

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